

**FILE COPY**

Office - Supreme Court, U. S.  
**FILED**

**MAY 14 1949**

**CHARLES ELMORE CROPLEY**  
CLERK

**IN THE**

# **Supreme Court of the United States**

**OCTOBER TERM, 1948**

**No. 745**

**RICHMOND SCREW ANCHOR CO., INC.,**  
a Corporation,

*Petitioner,*

**vs.**

**LAWRENCE H. UMBACH, Et AL,**

*Respondents.*

**BRIEF FOR RESPONDENTS ON PETITION FOR  
WRIT OF CERTIORARI**

✓  
mc **FRED GERLACH,**  
**NORMAN H. GERLACH,**  
105 West Adams Street,  
Chicago, Illinois,  
**Attorneys for Respondents.**



## INDEX

---

Foreword .....	1
Minor character of patents in suit .....	1
No question of general importance, or novel point of law involved .....	2
Argumentative findings of the District Court .....	3
Alleged absence of fabricators in other circuits not in record of case .....	3
Divergence between Court of Appeals and District Court .....	3, 4
Comments on "Matter Involved" and "Questions Pre- sented" stated by petitioner .....	5
Patents not included .....	5
Patent No. 1,957,610 includes claim for wedge .....	5
Court of Appeals held invalid all claims of Patent No. 2,020,912 .....	6
Court of Appeals did not rule on validity of Patent No. 2,222,339 .....	6, 7
Pinaud Patent relied on for prior invention .....	7
File Wrapper of Patent No. 2,107,130 not referred to by petitioner .....	7
Alleged secondary evidence .....	8
Court of Appeals explained patents, prior art and grounds for its conclusions .....	8
The District Court's findings discussed .....	8, 9
Argument .....	10
Old subject matter in patents in suit .....	10, 11
Patent No. 1,857,610 .....	10
Patent No. 1,919,751 .....	11
Patent No. 2,020,912 .....	11
Patent No. 2,107,130 .....	11

	PAGE
Patent No. 2,162,592 .....	11
Patent No. 2,222,339 .....	11
Lack of invention and disclosure in Patent No. 1,857,- 610 .....	12
Double patenting and invalidity of Patent No. 1,919,751 resulting from Claim 2 for same wedge in Patent No. 1,857,610 .....	13
Anticipation of and lack of disclosure in Patent No. 2,020,912 .....	15
File wrapper estoppel against anticipation of Patent No. 2,107,130 .....	18
Lack of invention in Patent No. 2,162,592 .....	19
Suit dismissed as to Patent No. 2,222,339 to eliminate finding of validity after non-infringement was ad- judged .....	20
Conclusion .....	21

#### TABLE OF AUTHORITIES.

Electric Fittings Corp. et al v. Thomas & Betts Co., 307 U. S. 241-242 .....	21
Florsheim v. Schilling, 137 U. S. 64, 72 .....	4
Hartford Empire Co. v. Shawkee Mfg. Co., 147 F. 2d 532, 555 (C. A. 3) .....	9
Hubbell v. United States, 179 U. S. 77, 80 .....	19
Knapp v. Morse, 150 U. S. 221, 224 .....	19
Lincoln Engineering Co. v. Stewart-Warner Corp., 303 U. S. 545, 549 .....	11
Milburn Co. v. Davis Bournonville Co., 270 U. S. 390 ....	7
Miller v. Eagle, 151 U. S. 186, 198 .....	4, 14

IN THE  
**Supreme Court of the United States**

OCTOBER TERM, A. D. 1948.

---

**No. 745**

---

**RICHMOND SCREW ANCHOR CO., INC.,**  
a Corporation,

*Petitioner,*

VS.

**LAWRENCE H. UMBACH, Et Al.,**

*Respondents.*

---

**BRIEF FOR RESPONDENTS ON PETITION FOR  
WRIT OF CERTIORARI**

---

*To the Honorable The Chief Justice and the Associate  
Justices of the Supreme Court of the United States:*

**FOREWORD.**

The patents in suit involve mere details in ties for use in molds for concrete walls, in an extremely old art, as shown by the patents in Exhibit Book Vol. II. and the statement of the Court of Appeals (R. 387):

“There are many prior art patents which disclose, as do the patents in suit, ties extending through the form walls and the concrete, spacers for holding apart the sides of the form for the concrete, devices for holding the walls on the ties during the pouring of the concrete and means to break off the projecting ends of the ties after the concrete has set.”

The detail or minor character of the alleged improvements in the patents in suit is apparent.

The first patent in suit (No. 1,857,610) is for pieces of wire welded on the rod to serve as spacers, many different forms of spacers being old, including elements welded on the tie.

The second patent in suit (No. 1,919,751) is for a detail in the wedge for holding the form on the tie, many forms of wedges being old.

The third patent in suit (No. 2,020,130) is for upsets on the tie serving as spacers and break-offs for the ends of the rods, both of which were old in several prior patents.

The fourth patent in suit (No. 2,017,130) is for a tie rod with a washer or disk confined between annular ribs on the tie, which the Court of Appeals held anticipated and not infringed.

The fifth patent (No. 2,162,592) is for a detail in the shape of the stop washer on the tie rod, contours for the same purpose being old in the art.

The sixth patent (No. 2,222,339) is for details on the tie, and was held not infringed in accord with the finding submitted by petitioner.

This minor character of the alleged novelty in the patents is clearly pointed out by the Court of Appeals. With respect to Patent No. 1,857,610, that court said:

“Either with or without any prior art, the process of attaching two metals by welding is so old and well known as to preclude the thought that its use could constitute invention.”

With respect to Patent No. 2,162,592, the Court of Appeals said (R. 402):

“in fact, without the aid of any prior art we would hesitate to dignify the disclosure with a patentable status.”

No question of general importance is involved. No important or novel question of law on the validity of the patents in suit is involved. Nowhere does the petition

point out how or why the opinion of the Court of Appeals in holding the patents in suit invalid, is not in accord with the precedents established in this court. No question of law is involved which has not heretofore been settled by the decisions of this court. The Court of Appeals applied, on most issues, decisions of this court in support of its findings.

The District Court relied upon argumentative findings adopted verbatim as submitted by petitioner, without an opinion or enlightening discussion of the issues. The Court of Appeals rendered an opinion with a complete discussion of the facts and law, and the comment that the argumentative findings of the District Court have "little, if any, value in support of the Court's conclusion of validity."

The petitioner, as a reason for allowance of the writ, urges that defendants and one other concern are the only competitors of the petitioner and they reside in the Seventh Circuit and that the possibility of further litigation and conflict of decision between the circuits is remote.

There is no evidence in the record to show that there are no competitors or other fabricators or sellers of tie rods for concrete forms throughout the United States. As a matter of fact there are large producers of tie rods for concrete wall forms, of which petitioner is aware, located in Miamisburg, Ohio, Birmingham, Ala., and Camden, N. J. The fact asserted by petitioner is not in the case and the authorities cited by petitioner are not applicable here.

The main divergence between the District Court and the Court of Appeals on the questions of anticipation and lack of invention arises from the erroneous principle which the District Court followed that anticipation or want of invention must be shown in a *single* prior art patent or device as set forth in the argumentative findings submitted



by petitioner in connection with each of the patents in suit.

The Court of Appeals said (R. 388):

“As we understand, plaintiff does not dispute but that the elements relied upon as patentable invention are found in the prior art, but its main contention is that the patents in suit are not anticipated because the improvements disclosed in connection with other elements claimed are not all shown in a single prior art patent.”

The Court of Appeals followed the rule of this court set forth in *Florsheim v. Schilling*, 137 U. S. 64, 72; 34 Law. Ed. 574, 578, to the effect that the entire prior art is to be considered, and held:

“Certainly it cannot be doubted that the entire prior art may be looked to, and the mere fact that some of the elements of a combination claim are found in one prior art patent and other elements in another does not render such art impotent as a guide for ascertaining novelty.”

The divergence between the District Court and the Court of Appeals on the issue of double patenting (Patent No. 1,919,751) arises from the failure of the District Court to follow the rule established by this court in *Miller v. Eagle*, 151 U. S. 186, 198, that a second patent to be valid must be for a separate invention distinctively different and independent from that covered by the first patent and must not consist of a mere distinction of the breadth or scope of the claims. It cannot cover matter inseparably involved in the matter embraced in the first patent. The Court of Appeals followed the decisions of this court and the District Court cited no authority on this point.

The reasons for the allowance of the writ set forth in pages 12 to 14 of the petition are not, we submit, of the character specified in rule 38, paragraph 5, of the rules of this court.



**Comments on Petitioner's Statement of "Matter Involved"  
(Pages 4 and 5) and "Questions Presented"  
(Pages 10 and 11).**

Validity of patents in suit No. 1,857,610, No. 2,162,592 and No. 2,222,339 is not included in petitioner's statement (pages 4 and 5) of the matters involved.

Paragraph 2 on page 4 of the petition with respect to Patent No. 1,919,751 does not indicate that the identical wedge is covered by Claim 2 of Patent No. 1,857,610 and that the claims of Patent No. 1,919,751 resulted in the patentee obtaining two patents for the same device, in violation of the rule against double patenting. The description and drawings in both patents with respect to the wedge and rod are identical, and Claim 2 of Patent No. 1,857,610 describes the wedge as "bottom heavy" while Claims 1 and 2 of Patent No. 1,919,751 include the same wedge with language referring to the same attributes of the wedge of the first patent, which make the wedge bottom heavy. The effect of the two patents for the same wedge was to prolong the monopoly of the same wedge beyond a single term of seventeen years and under the decisions of this court amounts to double patenting.

We challenge the accuracy or correctness of questions 1 and 2 on page 10 of the petition which impliedly involve "double patenting." The patentee procured Patent No. 1,857,610 with Claim 2 for a tie rod and a certain wedge, and procured a second patent, No. 1,919,751, for the identical wedge covered by Claim 2 of the first patent.

Petitioner's statement that the first patent did not claim the wedge is incorrect. The patentee illustrated, described and claimed in the second patent the identical wedge referred to in Claim 2 of Patent No. 1,857,610. A few days before the issue of the first patent the patentee filed the application for the second patent, No. 1,919,751, with an identical description and drawing of the wedge

and tie on which Claim 2 of the first patent was predicated, and claimed the same wedge with more detailed language as to the essential attributes of the "bottom heavy" wedge in Claim 2 of the first patent.

Nowhere in the petition is it asserted that the second patent is actually for a separate and distinct invention, which is the determinative point on "double patenting."

Under the title "Matter Involved" on page 5, (2), the petition states:

"The Court of Appeals held one unidentified claim out of the four claims [Patent No. 2,020,912] invalid."

This *misinterprets* the decision of the Court of Appeals, which held the entire patent invalid. That court (R. 392) said:

"It has four claims, all held to have been infringed. Claim 3 is illustrative."

The sentence quoted by petitioner (page 2, par. 3) refers to Claim 3, which was treated as illustrative of all four claims. The Court of Appeals said (R. 396):

"This patent does not disclose invention \* \* \*."

Obviously the court held that Claim 3 and all of the other claims of which it was illustrative, were invalid. The judgment (R. 404) of the Court of Appeals reversed the entire judgment in the District Court which held Claims 1 to 4 valid. The opinion in its entirety and the judgment of the Court of Appeals clearly show all of the claims of Patent No. 2,020,912 were held invalid.

The petition (p. 3, par. 6) misstates the holdings of the District Court and that of the Court of Appeals in connection with patent in suit, No. 2,222,339. It states, the Court of Appeals:

“\* \* \* in its amended opinion of March 15, 1949, held it invalid.”

The Court of Appeals made no holding on validity. It reversed the District Court because there was no dismissal of the complaint as to that patent after the charge of infringement was abandoned.

Questions 5 and 6 (p. 10) refer to the use of the Pinaud patent (Ex. Book II. 608) as a prior publication. The publication is not an issue. By reason of its earlier filing date, it establishes lack of novelty in Patent No. 2,020,912 under *Milburn Co. v. Davis Bournonville Co.*, 270 U. S. 390.

Questions 7 and 8 on page 10 of the petition, relating to Patent No. 2,107,130, are inaccurate and incomplete. They fail to indicate that the patentee, as shown by the file history of Patent No. 2,107,130, cancelled broad claims in view of the rejections of the Patent Office and ultimately limited the claim to the specific construction illustrated and described as explained by the Court of Appeals (R. 397) to induce allowance and thereby became estopped from asserting for the limited claim the scope of the rejected claims, as set forth in the opinion of the Court of Appeals (R. 400) where it said that the patentee—

“\* \* \* is estopped from asserting infringement of a device different from that claimed.”

Nowhere does petitioner attempt to show that the doctrine of file wrapper estoppel was not correctly applied by the Court of Appeals.

Question 8 refers to a patent “which is outside of the prior art” while the Court of Appeals definitely and distinctly held (R. 398):

“In our view, this Kahn disclosure is of the prior art and when so considered it discloses the element relied upon for novelty in the instant patent.”

The circumstance that the Examiner allowed the limited claim over this prior art patent is of no controlling effect on the validity of the patent in court.

Question No. 12 (page 11) of the petition refers to the failure of one charged with infringement to testify about the prior art. The devices here involved are so simple and obvious that neither party deemed it necessary to offer expert testimony concerning the prior art. The prior patents are self-explanatory. Question 12 as stated by petitioner is, we submit, inconsequential, if not frivolous.

Question 13, petition page 11, refers to so-called unidentified secondary evidence produced by respondents as insufficient to sustain the defense of lack of novelty. This, however, must refer to the chart (Defts.' Exhibit 18a, Page 259 of Vol. I Book of Exhibits). This chart is a reproduction from patents and publications in the prior art for convenience in reference. Every prior patent and publication illustrated on this chart is in evidence as a part of Defts.' Ex. 12 (Vol. II of Exhibits). Nowhere does it appear that the Court of Appeals relied in any way on, or even referred to this chart. In overruling petitioner's objection to the chart as secondary evidence, the District Court (R. 317) held:

"It doesn't change the drawings as they appear in the patents at all. Of course, if they did, they would give way to the patents."

This question raised by petitioner is immaterial and inconsequential.

Error 14 (p. 17) criticizes the findings of fact and conclusions of law. The Court of Appeals in every instance has set forth its reasons for its rulings on each patent in suit. It explained the prior art, the points of novelty asserted and explained the grounds of its conclusions.

As contradistinguished from this, the District Court adopted the findings submitted by petitioner and did not state any specific reasons in support of its findings.

In *Hartford Empire Co. v. Shawkee Mfg. Co.*, 147 F. 2d 532, the Court (C.C.A. 3) said (535 with respect to a finding-of-fact):

“Its office is to distill from the evidence which has been adduced at the trial of a disputed issue the pertinent facts which must be known by the court in order to enable it to determine and apply the relevant rules of law and thereupon to grant appropriate relief to the litigants.”

No salvaging features over the anticipations, selections, and mere changes in degree over the prior art, which were specifically urged by respondents, are identified in the findings of the District Court. While stating that the patents in suit are not anticipated, they fail to point out differentia over the prior art.

The character of the findings of the District Court is such that they do not merit the regard due findings which should be followed “unless clearly erroneous” or which are not obviously determinable by the reviewing court from the prior patents.

These devices are so simple in construction and obvious in operation and result that neither party offered expert testimony to explain the prior patents. The reviewing Court was qualified to pass judgment on the undisputed disclosures in prior art without being bound by the findings of the District Court.

### **ARGUMENT.**

#### **Subject Matter of the Patents in Suit.**

The Court of Appeals (R. 387) has clearly stated the general subject matter of the patents in suit and the prior art, where is said:

“Tie rods for supporting forms used in the construction of concrete walls were extremely old in the art. This is shown by scores of prior patents introduced by the defendants and relied upon as anticipating or showing a lack of invention in the patents in suit. There are many prior art patents which disclose, as do the patents in suit, ties extending through the form walls and the concrete, spacers for holding apart the sides of the form for the concrete, devices for holding the walls on the ties during the pouring of the concrete and means to break off the projecting ends of the ties after the concrete has set. The devices of all the patents in suit relate to ties, spacers and tie-holders, and it is contended by defendants that they utilize these old combinations of elements so as to perform the same old functions and to obtain the same or similar results.”

With respect to the prior art, the Court of Appeals (R. 388) said:

“Ties of different shapes—round wire and flat bars—were old. Spacers on the tie rod for the concrete form, in a wide diversity of detail, were old. Holders on the ties for the sides of the form in the form of wedges, screws, welded and integral members were old, as well as means for twisting or breaking off the rod in the concrete after the latter had hardened.”

Particularizing the subject matter of the patents in suit and the rulings thereon:

*Patent No. 1,857,610* for welding pieces of wire on the rod to function as stops and a wedge for hold-



ing the form on the tie, was held invalid by the Court of Appeals for lack of invention, which reversed the District Court, which held them valid but not infringed.

*Patent No. 1,919,751* is for the same wedge defined in Claim 2 of the first patent, and the Court of Appeals held this patent was void for double patenting.

*Patent No. 2,020,919* is for upsets on the tie engaged by washers which engage the form. The Court of Appeals held the invention substantially anticipated by Pinaud Patent No. 2,095,714 (Ex. Book II 608) and that invention was lacking. Such upsets were also old in other patents.

*Patent No. 2,107,130* is for securing a washer between two annular ribs on the tie in the concrete. The Court of Appeals held that the claim was limited by file wrapper estoppel and not infringed, and also that the washer and ribs on the rods were anticipated by Kahn Patent No. 768,284 (Ex. Book II 62). Non-infringement was admitted by plaintiff.

*Patent No. 2,162,592* is for a washer with bumps or deformations. The Court of Appeals held invention was lacking in view of several prior art patents which exhibited formations for the same purpose.

*Patent No. 2,222,393* is for a tie adapted to be pulled out of the concrete, which the District Court held valid but not infringed. It did not dismiss the complaint as to this patent. The Court of Appeals held the complaint should have been dismissed and without a finding of validity of this patent.

In *Lincoln Engineering Company v. Stewart-Warner Corp.*, 303 U. S. 545, 82 L. Ed. 1008 (1910) this Court said:

“And the improvement of one part of an old combination gives no right to claim that improvement in com-



bination with other old parts which perform no new function in the combination.”

It appears from the decision of the Court of Appeals that the patents in suit are for old combinations and old elements which perform no new function in the combinations. The petition does not point out how the old elements in the old combination perform any different function or achieve any new result.

### **Patent in Suit No. 1,857,610.**

Plaintiff charged infringement of claims 1, 2 and 5. This patent exhibits the usual tie rod. Cross-pieces of wire are welded to the rod to serve as spacers for the form boards. Although plaintiff abandoned the charge of infringement in the findings submitted to the District Court, the claims were held valid but not infringed, after respondents had introduced the prior art to establish anticipation and lack of invention.

The Court of Appeals held that the tie rod and mere welding of pieces of wire thereon as stops for the form boards, was lacking in invention “either with or without any prior art” (R. 390). Anticipation is clearly shown by the prior patent to Alley, No. 1,746,298 (Vol. II Book of Exhibits, 480), and others, which were not mentioned in the opinion of the Court of Appeals.

The Court of Appeals also held that the criteria for producing an alleged brittleness in the rod specified in claims 1 and 5 were not disclosed (R. 390) in the patent and that the claims were void for lack of such disclosure. Plaintiff’s President admitted this lack of disclosure and said it would “disclose the secrets of the business” (R. 391).

The petition fails to assert any error in or any ground for review of patent in suit, No. 1,857,610, as to its invalid-

ity, or for lack of invention and, therefore, we assume that this court will give no consideration to this issue.

Patent in suit, No. 1,857,610, discloses on the tie, a wedge for holding the form boards, which the specification of the patent described as "bottom heavy" or having a preponderance of metal below its midpoint. Claim 2 of this patent specifies this "bottom heavy" wedge. The District Court held this Claim 2 valid but not infringed.

The Court of Appeals held this Claim 2 in Patent No. 1,857,610, which specified this wedge, rendered invalid for double patenting, the claims of the second patent in suit, No. 1,919,751, for the same wedge.

The disclosure of this wedge and claim 2 in the first patent in suit [No. 1,857,610] are the basis of the decision of the Court of Appeals that the second patent in suit [No. 1,919,751] is void for "double patenting".

#### **Patent in Suit No. 1,919,751.**

This patent No. 1,919,751 (Vol. I Ex. Book, p. 24) in Figs. 1, 2, 3 and 4, illustrates the *identical* tie and wedge exhibited (Vol. I of Ex. Book, p. 2) in Figs. 1, 2, 3 and 4 of patent in suit No. 1,857,610.

Both patents contain an *identical description* of the wedge.

Claim 2 of Patent No. 1,857,610 includes this wedge and defines it as "bottom heavy", which is asserted to be its distinctive structural characteristic.

The claims of Patent No. 1,919,751 define and describe the *identical* wedge illustrated, described and claimed in the earlier patent.

The claims of the second patent are predicated on the same "bottom heavy" wedge as claim 2 of the first pat-

ent. The claims of the second patent merely add the enlarged portions or the specific details which are present in and are necessary to render "bottom heavy" the wedge defined in claim 2 of the first patent. The differences in the claims of the two patents are mere matters of language or description applicable to the same wedge and are not for separate or distinct inventions in the same wedge. The claims of both patents are predicated on and cover the *identical* wedge.

The second patent, if valid, prolongs petitioner's monopoly for the wedge beyond the term of the first patent. That is the basic vice of double patenting, and upon these premises the Court of Appeals held the second patent was void for double patenting (R. 392).

The Court of Appeals cited *Miller v. Eagle*, 151 U. S. 186, 198, 38 Law Ed. 121, 127, which held:

"The result of the foregoing and other authorities is that no patent can issue for an invention actually covered by a former patent, especially to the same patentee, although the terms of the claims may differ \* \* \* it [later patent] must be something substantially different from that comprehended in the first patent. It must consist in something more than a mere distinction of the breadth or scope of the claims in each patent. \* \* \* The matter sought to be covered by the second patent is inseparably involved in the matter embraced in the former patent, and this, under the authorities, renders the second patent void".

The claims of petitioner's second patent differ only from Claim 2 of the first patent in the language or scope of the claims applied to the same wedge. The details specified in the claims of the second patent are inseparable from the wedge defined in Claim 2 of the first patent.

The Court of Appeals held (R. 391):

"When the drawings and specifications of the latter patent are taken into consideration, we find the iden-

tical wedge described in the claims of patent No. 1,919,751."

The Court of Appeals in holding petitioner's second patent void followed the foregoing authority of this court.

Nowhere in the petition does the petitioner attempt to show that the differences in the language of the claims define separate or distinct inventions, or that the monopoly of the first patent under Claim 2 would not be unlawfully prolonged by the second patent, if valid.

Copendency of the applications referred to by petitioner (Brief pp. 5 & 6) does not salvage the second patent from "double patenting" because whatever invention may be asserted for the same wedge, it was indivisible. The District Court referred to no authority in support of its decision on this point. There was no requirement for division by the Patent Office.

Additionally respondents urged as grounds for invalidity and lack of invention of the claims of patent No. 1,919,751, Colt Patent No. 1,552,912 (Vol. II Ex. Book 320) which shows a "bottom heavy" wedge and Hagen patent No. 1,743,915 (Vol. II of Ex. Book 476) and Hearn patent No. 1,579,764 (Vol. II of Ex. Book 430). The Court of Appeals, in view of double-patenting, did not rule on these other defenses.

#### **Patent in Suit No. 2,020,912.**

The alleged novelty of this patent is asserted to be in the upset collars or bulges on the tie to function as stops for the washers in lieu of other forms of stops or spacers. These upsets were old in the art, as exemplified by Fahrney Patent No. 921,211 (Ex. Book II, p. 134), LaMorte Patent No. 1,765,729 (Ex. Book II, p. 480), the publication of Central States Tie (Ex. Book I, p. 255a) and Pinaud

Patent No. 2,095,714 (Ex. Book II, p. 608) which was applied for prior to the application for patent in suit No. 2,020,912.

The Court of Appeals without reference to any of these except said Pinaud patent held (R. 394):

“Pinaud, in our judgment, comes close to being a complete anticipation. It discloses a tie rod, integral collars or upsets on the rod, and washers engaging the stops and the inner side of the form; slitted portions of the rod in the body of the concrete at which the ends of the tie are broken off. It shows a flat washer maintained against upsetting portions formed on the rod. There, as here, the rods are twisted off within the body of the concrete, the spacers or upsets integral with the rod and the washers are spaced on the rod by the upsets. The Pinaud patent was not cited by the Patent Office.”

Question 6 (p. 10) and petitioner's brief (p. 28) refer to the use of Pinaud Patent No. 2,094,814, as a prior publication. This prior patent was not used as a prior publication. By reason of its filing date earlier than any date established by the patentee of No. 2,020,912 Pinaud establishes that said patentee was not the first inventor.

The application for the Pinaud patent was filed in the Patent Office April 21, 1934 (Ex. Book II, p. 609). Schenk patent in suit, No. 2,020,912, was applied for May 31, 1934 (Ex. Book I, p. 49). The prior filing date of Pinaud establishes the earlier date of invention, in the absence of evidence carrying the date of the invention of patent No. 2,020,912 back of Pinaud's filing date. Schenk was not the first inventor. No such evidence was offered. The later issue of the Pinaud patent, or that the Pinaud patent is not a prior publication, are immaterial. Under the rule established by this court in *Milburn Co. v. Davis Bournonville Co.* in 270 U. S. 390, 70 L. Ed. 651, the prior filing of

an application establishes the defense that the later applicant was not the first inventor.

Prior knowledge, as shown by the Pinaud patent was pleaded (R. 44). In the District Court and the Court of Appeals petitioner did not challenge the availability of Pinaud's earlier filing date to establish that Schenk was not the first inventor. It relied on alleged differences which the Court of appeals overruled where it held the Pinaud patent was a substantially complete anticipation.

The Court of Appeals specifically mentioned Pinaud Patent No. 2,095,714, but there are several other defenses of invalidity which were not mentioned by that court, because they were not necessary and cumulative. The Court of Appeals said (R. 396):

"The break-off element adds nothing to the novelty of the claims and this is so with or without the prior art. It consists of nothing more than a cut or indentation in the wire at the point desired, which inevitably weakens it at that point".

Defendants' Exhibit 9a, reproduced on pages 255 and 255a of Vol. I of Exhibits, is a publication issued July 31, 1931 by the *Central States Manfg. & Engineering Company of Kansas City, Kan.*, (R. 286, R. 293) prior to the application date (May 31, 1934) for patent No. 2,020,912. This publication exhibits a tie rod with upset collars or bulges and washers engaging the collars substantially the same as the tie rod, collars and washers claimed in Patent No. 2,020,912, with the single exception that it does not disclose the break-off notches which the Court of Appeals held, in the foregoing quoted statement, added nothing to the novelty of the claims. In *Kininger et al. v. Emerson Co.* (62 Fed. Sup. 545) Patent No. 2,245,559, which claimed these break-offs inwardly of the outer surface of a wall, was held invalid.



The Pinaud patent is but one of several instances in the prior art which establish anticipation or lack of invention in the claims of patent in suit, No. 2,020,912.

Additionally, the Court of Appeals held (R. 395) that their patent in suit failed to disclose how the tie was strengthened at the upsets, according to the claims. The petition does not challenge that finding.

### **Patent No. 2,107,130.**

The file wrapper proceedings (Ex. Book I, p. 90) which resulted in the allowance of the single claim specifically limited to a disk or a washer held on the rod by—

“ \* \* \* an annular raised rib integrally formed on the rod on *each* side of the disk ”

have been fully pointed out by the Court of Appeals (R. 397).

Petitioner's President Snyder admitted that defendants' tie rod did *not* infringe and does not function like the patent, as pointed out by the Court of Appeals (R. 399).

With respect to petitioner's claim that defendants' device infringes, the Court of Appeals said (R. 398):

“ The fallacy of this argument is evident when it is considered that claims which are sufficiently broad to cover such a construction were rejected and that the claim as allowed was specifically limited in the manner above indicated. ”

The District Court apparently disregarded the file wrapper history, while the Court of Appeals held that patentee (R. 400):

“ \* \* \* is now estopped from asserting infringement on a device different from that claimed, even though under different circumstances it might constitute infringement under the doctrine of equivalency ”



citing the decisions of this court in *Knapp v. Morse*, 150 U. S. 221, 224 and *Hubbell v. United States*, 179 U. S. 77, 80.

Nowhere in the petition does petitioner point out any error in the application of the doctrine of file wrapper estoppel which the Court of Appeals cited.

The District Court did not mention the file wrapper history in its findings.

Upon Kahn Patent No. 768,284 (Ex. Book II, p. 62) the Court of Appeals held Patent No. 2,106,130 invalid and said (R. 398):

"In our view this Kahn disclosure is of the prior art and when so considered it discloses the element relied on for novelty in the instant patent."

#### **Patent in Suit No. 2,162,592.**

This patent is for a cone-shaped washer or spacer designed for forming a socket or depression in the concrete wall and around the end of the rod.

The Court of Appeals held (R. 400):

"That cones for such purpose were an old expedient is not open to doubt. The sole novelty asserted for this claim is that it provided for 'a conical concrete-contacting face provided with a plurality of spaced projections pressed out of the body of the disk [cone] \* \* \* whereby a plurality of spaced recesses or pockets free from communication with either the inner or outer ends of the depression formed in the wall will be produced in said depression for the reception of pointing concrete'."

As the Court of Appeals pointed out (R. 401) the formation of pockets or recesses in the wall by contours on the cones for the same purpose were old in McCarty patent No. 915,955 (Ex. Book II, p. 108), Whitescarver patent No. 1,665,649 (Ex. Book II, p. 400), and Ander-

son patent No. 1,950,008 (Ex. Book II, p. 560). The Court of Appeals said with respect to Whitescarver (R. 401):

“Here again is a disclosure of the idea relied upon for invention in the instant patent.”

From the decision of the Court of Appeals it is clearly apparent that there is no invention in a mere change in the shape of the formations on the cone. During the pendency of the application for this patent, the Examiner (Ex. Book I, p. 109) said:

“It is axiomatic that it does not amount to invention to shape any molding surface so that it will have the proper contour to give the desired shape to the molded product. Once having the design of the surface desired in the depression molded by a spacer cone, it is obvious to shape the molding surface of the cone accordingly.”

The Examiner further held (Ex. Book I, p. 12):

“\* \* \* such differences as exist between applicant's spacing disc and that of Whitescarver are held to be merely matters of design since no improvement or change in function is accomplished.”

Nowhere in the petition has petitioner attempted to point out that the slight differences in the shape of the formations on the washer are of any mechanical consequence or inventive.

#### **Patent in Suit No. 2,222,339.**

The petition apparently seeks no review with respect to this patent and for that reason it may not be considered by this court. There is, however, an obvious error in the petition concerning the ruling of the Court of Appeals.

The District Court, after petitioner's admission that respondents had not infringed, entered judgment that

this patent was valid (R. 349, p. 2) but did *not* dismiss the complaint as to that patent. The only reference to this patent in the judgment was that it was valid. The validity of the patent was not litigated and plaintiff's admission of non-infringement rendered the question of validity moot.

Because the District Court did *not* dismiss as to this patent, the Court of Appeals held (R. 402):

"Defendants contend that plaintiff's concession of non-infringement rendered the question of invalidity moot and that the complaint as to this patent should have been dismissed. The authorities relied upon support this contention."

Reversal was adjudged in accordance with the rule laid down by this court in *Electrical Fittings Corp., et al., v. Thomas & Betts Co., et al.*, 307 U. S. 241-242. When there is no infringement, the complaint should be dismissed, which the District Court did not do.

### CONCLUSION.

For the foregoing reasons we respectfully submit that the Petition for the Writ of Certiorari should be denied.

Respectfully submitted,

FRED GERLACH,  
NORMAN H. GERLACH,

*Counsel for Respondents.*